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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,186	04/19/2001	Matthew L. Meyerson	7032/2002	1540

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EXAMINER

ALLEN, MARIANNE P

ART UNIT PAPER NUMBER

1631

DATE MAILED: 09/16/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/839,186

Applicant(s)

MEYERSON, MATTHEW L.

Examiner

Marianne Allen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-61 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, 10-18, 23-26, 29-31, and 50-61, drawn to a method of using a computer system to identify a microbe inhabiting a host organism, classified in class 702, subclass 20.
- II. Claims 8-26 and 29-31, drawn to a method for identifying intracellular pathogens, classified in class 702, subclass 20.
- III. Claim 27, drawn to a method of probing a library, classified in class 435, subclass 6.
- IV. Claim 28, drawn to a method of producing a peptide, classified in class 435, subclass 69.1.
- V. Claims 32-33, drawn to a second method of producing a peptide, classified in class 435, subclass 69.1.
- VI. Claim 34, drawn to a method of treatment using a peptide, classified in class 514, subclass 12.
- VII. Claims 35-37, drawn to a method of treatment using nucleic acids, classified in class 514, subclass 44.
- VIII. Claim 38, drawn to a hybridization assay, classified in class 435, subclass 6.
- IX. Claims 39-49, drawn to a system and computer program product, classified in class 707, subclass 100.

The inventions are distinct, each from the other because of the following reasons:

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The methods of Groups I-VIII can be shown to be distinct, each from the other, because they have different method steps and goals. It is noted that Groups I and II list claims in common based upon the multiple dependency of the claims. The multiply dependent claims will be examined only to the degree that they reflect the elected base invention of claims 1-7 (for Group I) or 8 for (Group II). It is noted that Groups III-VIII list claims multiply dependent upon those for Groups I and II. If any of Groups III-VIII is elected, applicant must further elect the base method set forth in independent claims 1, 2, 3, or 8 and examination of the claims will be restricted as such. Each of these groups reads upon multiple patentably distinct inventions. The product of Group IX can be shown to be distinct from each of the methods of Groups I-VIII as the methods do not require this system or computer program product.

Because these inventions are distinct for the reasons given above and the search required for Groups I-IX are not coextensive, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 703-308-0666. The examiner can normally be reached on Monday-Friday, 9:00 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703-308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

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Marianne P. Allen

Marianne P. Allen
Primary Examiner
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mpa
September 11, 2002